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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,118	11/19/2003	Kevin Krietemeyer	12406/79	9903

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER	
FERNSTROM, KURT	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,118	KRIETEMEYER, KEVIN	
	Examiner	Art Unit	
	Kurt Fernstrom	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25 and 28-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25 and 28-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-5, 8-10, 13, 16, 17, 20, 24 and 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis in view of Novak. Jarvis discloses in Figures 1 and 2 and in column 2, line 24 to column 3, line 18 of the specification a method and device of playing a lottery comprising a gaming slip 12 comprising a substrate having gaming information printed thereon, including a random request region 26 that enables a plurality of computer-generated picks to be requested in conjunction with a lottery. Column 3, lines 3-17 in particular discusses the use of a computer to generate picks when a random request is received. Jarvis fails to disclose that a plurality of quick picks may be selected for a single game. Novaks discloses in Figure 4 and in column 9, lines 51-64 that a lottery game whereby a player may enter a plurality of quick picks for the same game. Column 5, lines 27-33 also discloses a plurality of quick picks for the same game. It would have been obvious to one of ordinary skill in the relevant art to modify the device and method comprising a random request region which enables a plurality of computer-generated picks to be requested for a single game for the purpose of allowing the user to easily generate a plurality of picks for a

game, thereby increasing the chances of winning. With respect to claims 3 and 13, column 3, lines 3-17 further discusses the selection of six numbers when a random request is received. With respect to claims 4 and 8, Jarvis discloses that a manual selection region 14 including one or more manually selected numbers is provided which enables a manual pick to be made. With respect to claim 5, Jarvis discloses that a draw request region 22 is provided which enables picks to be played for a plurality of drawings. With respect to claims 17 and 20, a machine readable medium as claimed is inherent in the disclosure of Jarvis, in particular that portion which discusses the use of a computer to generate random numbers in response to a random request. It should also be noted that claim 17 recites a machine readable medium **to store** a set of instructions. By reciting the invention as an intended purpose, rather than a positive limitation, in strict terms any computer readable medium reads on claim 17, and thus claims 18-20, as written. With respect to claim 28, Jarvis is silent as to the material used for the ticket. However, Official Notice is taken that paper is an extremely well known type of material to use for gaming slips, and would have been an obvious means to allow a user to request numbers which can then be fed into and processed by a computer. With respect to claims 37 and 40, Jarvis discloses in the specification that the areas of the gaming slip are to be marked with a writing instrument.

Claims 2, 6, 7, 11, 12, 14, 15, 18, 19, 29-33, 35, 36, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis in view of Novak, and further in view of Alvarez. Jarvis as viewed in combination with Novaks discloses all of the limitations of the claims with the exception of the substrate having gaming information

corresponding to different types of games. Alvarez discloses in Figures 4-7 and in column 5, line 37 to column 6, line 10 of the specification a device and method comprising a substrate 10 having gaming information corresponding to different types of games thereon. Figures 6 and 7 in particular show gaming information corresponding to different types of games, where the sections of Figures 6 and 7 are part of the same substrate as shown in Figures 4 and 5. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Jarvis as viewed in combination with Novak by providing gaming information corresponding to different types of games for the purpose of allowing a user to easily select numbers for different types of games. While the substrate of Alvarez does not disclose or suggest random request regions, this feature is already suggested by Jarvis as viewed in combination with Novak. With respect to claim 19, the game data, by being read into a computer as disclosed by all of the Jarvis, Novak, and Alvarez references, is inherently tracked.

Claims 21-23 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis in view of Novak and Alvarez, and further in view of Alexoff. Jarvis as viewed in combination with Novak and Alvarez discloses all of the limitations of the claims with the exception of marking one box to indicate the number of computer-generated picks to be played. Alexoff discloses in Figure 4 a gaming slip with a "Number of Plays" section at the bottom, where the player selected the number of picks to be plays by marking one box. While in the primary embodiment of Alexoff this feature is generally related to the number of consecutive days on which picks are to be played, Alexoff discloses in column 4, lines 1-16 an alternative embodiment where a player may

play multiple picks for the same drawing. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Jarvis as viewed in combination with Novak and Alvarez by providing and area whereby a player may mark a box to select the number of picks to be played for the purpose of providing "instant gratification" to a user, as discussed at column 4, lines 11-16 of Alexoff. With respect to claim 22, the selection of ten picks is considered to be an obvious variation on Alexoff, which discloses the selection of up to seven picks by marking a box.

Response to Arguments

Applicant's arguments filed on June 30 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Jarvis and Novak are not properly combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While Jarvis is directed to a manual paper-and-pencil type device and method, and Novak is directed toward a computer device and method, both are directed towards playing lottery games. One of ordinary skill in theart would have understood that the teachings of Novak could be incorporated in a manual game slip such as that of Jarvis, particularly given that there is no inherent contradiction in the

teachings or other obstacle which would render the game slip of Jarvis unsuitable for its intended purpose. Rather, the proposed modification amounts to nothing more than a duplication of the feature disclosed by Jarvis; that is, more than one random request is made for each single game. The concept of allowing a person to make multiple quick picks for a single game is taught by Novak. One of ordinary skill in the art, viewing the combined teachings of the references, would have found the invention obvious.

In response to applicant's argument that there is no suggestion to combine the Alvarez and Alexoff references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Alvarez discusses throughout the specification a substrate having a plurality of panels relating to different games, where the user can fill out several panels at once and turn the card in to an authorized lottery ticket dealer. This discussion inherently teaches a motivation for providing a multigame card; that is, allowing a user to easily and conveniently play different types of games at once. Again, one of ordinary skill in the art, viewing the combined teachings of the references, would have found the invention obvious.

With respect to the Alexoff reference, it appears that further clarification is needed as to what features the examiner is relying on in the rejection. Figure 4 shows a

play slip which a user fills out. Near the bottom of the slip is a "Number of Plays" section, where the user fills in a single box to indicate a number of plays from zero to seven. While the primary embodiment of this feature is directed to the number of consecutive days a pick is to be made, Alexoff discloses in column 4, lines 1-16 that in an alternative embodiment it can be used to make a plurality of picks for the same day. While this portion of the specification discusses the game ticket, the game ticket is simply the result of what has been filled out in the game slip shown in Figure 4. The teachings of Alexoff, combined with those of the other references, thus suggest the limitations of claims 21-23 and 34.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M, T, Th 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
September 28, 2006

KURT FERNSTROM
PRIMARY EXAMINER